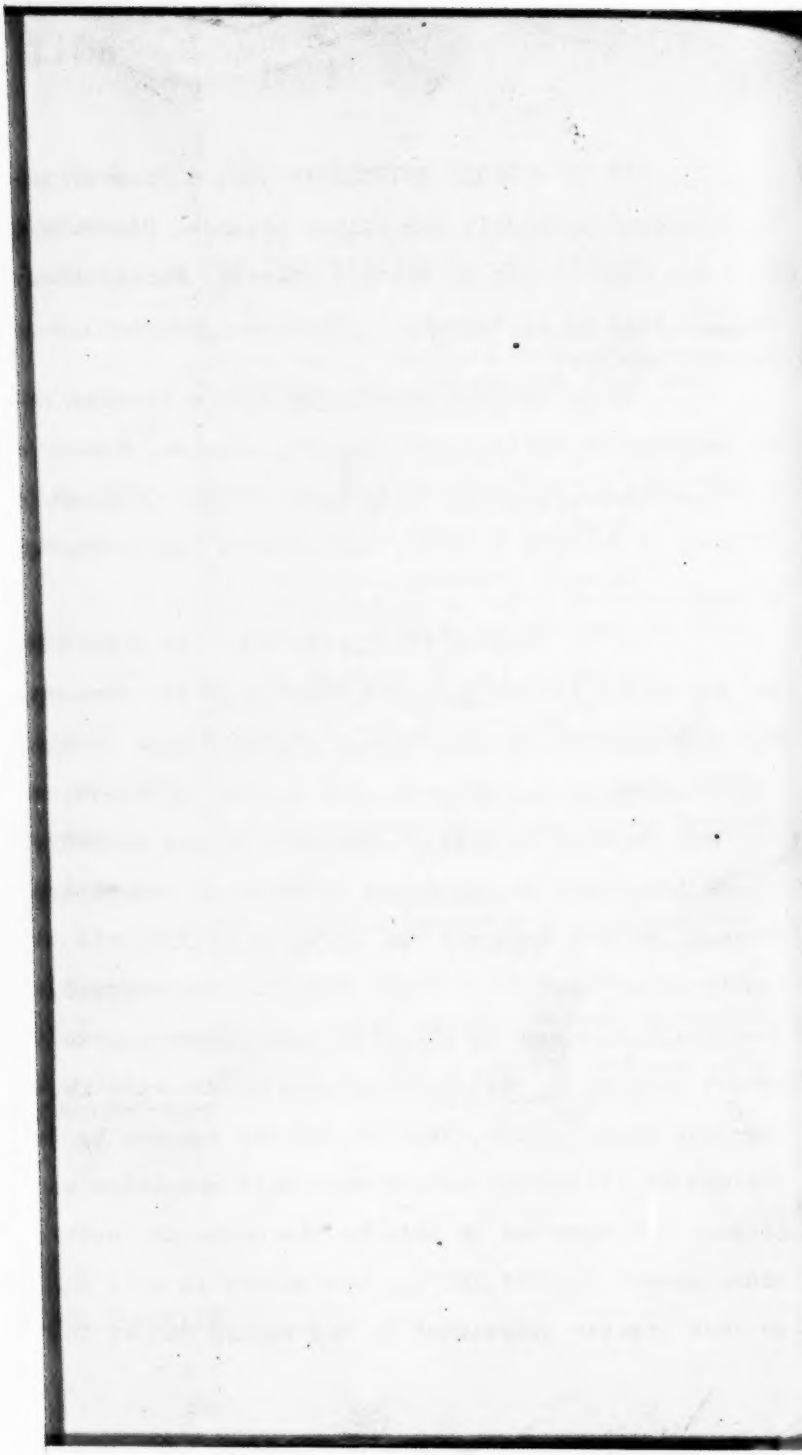

FILE COPY

Office Supreme C
F I L E
APR 23
CHARLES E. MC

Supreme Court of the United States

OCTOBER TERM, 1928

No. 71

MINERALS SEPARATION NORTH AMERICAN CORPORATION,

Petitioner,

—against—

MAGMA COPPER COMPANY,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT AND BRIEF IN SUPPORT THEREOF.

HENRY D. WILLIAMS,
WM. HOUSTON KENYON,
LINDLEY M. GARRISON,
SIDNEY ST. F. THAXTER,
FREDERIC D. MCKENNEY,
Counsel for Petitioner.

Alpert Press, Sperry Bldg., 40 Flatbush Ave. Ext., B'klyn, Phone TRI 1058

SUBJECT INDEX

	Page
Petition for a writ of certiorari	1
Summary statement of matter involved	1
Reasons relied on for allowance of writ	1
1. Conflict of decisions	2
2. Failure to give proper effect to applicable decisions of this Court	3
Importance of patented invention	4
Prayer for writ	5
Brief in support of Petition for certiorari	7
Processes of patents Nos. 835,120 and 962,678 compared	7
Applicable holdings in Minerals Separation Limited v. Hyde	9
Applicable holdings in Minerals Separation Limited v. Butte & Superior Mining Company	9
Erroneous holding by the Circuit Court of Appeals in the instant case	11
Contrasting opinion of the District Court	11
Discovery and invention of the patent in suit	12
Use of complex manufactured products containing both insoluble and soluble mineral-frothing agents is joint use of processes of both patents Nos. 835,120 and 962,678	13
Conclusions	14

TABLE OF CASES

Minerals Separation Limited v. Hyde, 242 U. S. 261	1, 3, 7, 9
Minerals Separation Limited v. Miami Copper Company, 244 Fed. 752 (C. C. A. 3)	1, 2, 7, 14
Minerals Separation Limited v. Miami Copper Company, 237 Fed. 609 (D. C., Del.)	2
Minerals Separation Limited v. Butte & Superior Mining Company, 250 U. S. 336	1, 4, 7, 9, 14
Minerals Separation Limited v. British Ore Concentration Syndicate Limited, 27 R. P. C. 33	3, 9

PRESENT CASE IN THE COURTS BELOW

Minerals Separation North American Corporation v. Magma Copper Company, D. C., 23 F. (2d) 931, R. Vol. I, p. 921	11
Magma Copper Company v. Minerals Separation North American Corporation C. C. A., 1st, 30 F. (2d) 67, R. Vol. I, p. 943	2, 3, 11

Supreme Court of the United States

MINERALS SEPARATION NORTH AMERICAN CORPORATION,
Petitioner,

—vs.—

MAGMA COPPER COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE JUDGES OF THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, Minerals Separation North American Corporation, respectfully represents as follows:

I. In the instant case the Circuit Court of Appeals for the First Circuit

(1) has rendered a decision (30 Fed. (2d) 67, R. Vol. I, p. 943) in conflict with a decision of the Circuit Court of Appeals for the Third Circuit on the same matter (*Minerals Separation Limited* v. *Miami Copper Co.,* 244 Fed. 752), and

(2) has not given proper effect to applicable decisions of this Court (*Minerals Separation Limited* v. *Hyde,* 242 U. S. 261, and *Minerals Separation Limited* v. *Butte & Superior Mining Company,* 250 U. S. 336).

II. The instant suit is a suit in Equity begun January 9, 1920, in the United States District Court for the District of Maine, for infringement of United States Letters Patent, and was tried and decided as to infringement of claims 1 and 2 of United States Letters Patent No. 962,678, for a process of ore concentration granted June 28, 1910, to Sulman, Greenway and

Higgins and owned by your petitioner. The Circuit Court of Appeals for the First Circuit held the patent in suit, No. 962,678, claims 1 and 2, anticipated by a prior patent, No. 835,120, and invalid, expressly refusing to follow the Circuit Court of Appeals for the Third Circuit in the *Miami* case above referred to, which on substantially the same facts had held patent No. 962,678, claims 1 and 2, not anticipated by said prior patent No. 835,120, and valid and infringed. Accordingly, in the instant case, the decree in the District Court (which had followed the Circuit Court of Appeals for the Third Circuit in the *Miami* case) was reversed, Anderson, *C. J.*, concurring in the result (Opinion, R., Vol. I, p. 943; 20 Fed. (2d) 67), the decree of reversal being dated January 10, 1929 (R., Vol. I, p. 956). The time for filing this petition has been extended to and including April 30, 1929 (R., Vol. I, p. 960).

III. The suit in the Third Circuit above referred to, *Minerals Separation Ltd.* v. *Miami Copper Company*, was a suit in equity begun October 10, 1914, in the United States District Court for the District of Delaware for the infringement of United States Letters Patent including patent No. 835,120 and patent No. 962,678, claims 1, 2 and 12, and a third patent No. 1,099,699. The proofs there included substantially the same prior art against patent No. 962,678, claims 1 and 2, that is proved in the instant case. In the District Court there the patent No. 835,120 and patent No. 962,678, claims 1, 2 and 12, were by the Honorable Edward G. Bradford, *D. J.*, on September 29, 1916, held valid and infringed (237 Fed. 609; at 634-636 as to patent No. 962,678).

On appeal the Circuit Court of Appeals for the Third Circuit, on May 24, 1917, held the three patents there in suit valid and infringed as to some of the claims thereof, including patent No. 962,678, claims 1 and 2 (244 Fed. 752; at 770-774 as to that patent). The dissent expressed by Judge Buffington, *C. J.*, discussed only the question of infringement of patent No. 835,120 (244 Fed. 775-792).

IV. It is with this decision of the Circuit Court of Appeals for the Third Circuit in the *Miami* case that the decision

of the Circuit Court of Appeals for the First Circuit in the instant case is in conflict, as heretofore stated.

This conflict is explicitly admitted upon the face of the decision of the Circuit Court of Appeals for the First Circuit in the instant case. At page 948 of the Record (30 F. (2d) at 69) it is said by that Court,

> "apparently they [the plaintiffs] have obtained a decision to that effect [holding *inter alia* claims 1 and 2 of patent No. 962,678 valid and infringed] in *Miami Copper Company* v. *Minerals Separation, Limited,* 244 Fed. 752",*

and again on pages 955, 956, of the Record (30 F. (2d) at 72) that decision of the Circuit Court of Appeals for the Third Circuit is discussed and at the conclusion of the paragraph appears the statement

> "We, therefore, decline to follow the decision in the *Miami* case."

V. On December 11, 1916, this Court rendered a decision in *Minerals Separation, Ltd.* v. *Hyde* (242 U. S. 261), involving the validity of patent No. 835,120, in which this Court compared the process of that patent with prior art processes and differentiated and defined it and sustained the patent No. 835,120 (as to some of its claims) as valid and infringed, referring in its opinion to a prior decision of the House of Lords (as to the equivalent of the process of patent No. 835,120) in *Minerals Separation, Ltd., et al.* v. *British Ore Concentration Syndicate, Ltd.*, 27 R. P. C. 33, and quoting from the opinions in that case as to the nature of that process, as more particularly pointed out in the accompanying brief. This decision of this Court was rendered pending the appeal in the *Miami* case from the District Court to the Circuit Court of Appeals for the Third Circuit and prior to the argument of that appeal,

---

* Unless otherwise indicated, bracketted portions and italicizing in quotations will be ours.

and it received careful and controlling consideration in the subsequent decision of that case.

VI. On June 2, 1919, this Court rendered a further decision as to patent No. 835,120 in *Minerals Separation, Ltd., et al.* v. *Butte & Superior Mining Co.*, 250 U. S. 336, in which this Court reconsidered and reaffirmed the validity of patent No. 835,120. No change was announced in that opinion in the view this Court took of the nature of the process of patent No. 835,120 (as pointed out in the accompanying brief). This Court there considered the scope of the claims of that patent for the purposes of specific new questions of infringement.

VII. The Circuit Court of Appeals for the First Circuit in the instant case referred in its opinion to the two decisions of this Court aforesaid but, your petitioner submits, misunderstood and misapplied them and, therefore, did not give proper effect to these applicable decisions of this Court, as pointed out in the accompanying brief.

VIII. The present invention of patent No. 962,678 has made possible (either when used alone as by the respondent here and others, or when conjointly used with the invention of patent No. 835,120, and, in the case of some ores, with the invention also of patent No. 1,099,699 of the *Miami* case) the concentration by froth-flotation of the *porphyry copper ores*, a great class of ores which were not amenable to concentration by any flotation process prior to the invention of the process of the patent in suit No. 962,678. Those porphyry copper ores are now, i. e., when concentrated by aid of the process of patent No. 962,678, the world's greatest source of copper. The present invention therefore represents a momentous and revolutionary forward step in the practical metallurgical art.

IX. Two other mining companies besides the defendant in the instant case, infringed the patent in suit without license and suits are now pending against those other companies and

those suits are held in abeyance pending the determination of the instant case, namely, *Minerals Separation North American Corporation* v. *St. Louis Smelting & Refining Co.*, in the District of Missouri, and *Minerals Separation North American Corporation* v. *National Lead Co.*, in the District of New Jersey.

X. Although the patent expired on June 28, 1927, the liability of the defendant for its continuing infringement from before the commencement of the suit on January 9, 1920, until the expiration of the patent, and the liability of the other two mining companies, defendants aforesaid, is in the aggregate a very substantial amount. The royalties which would have been payable to your petitioner on the infringing operations of the defendant in the instant case and on the infringing operations of the other two defendants named, had these three mining companies taken licenses and paid the established royalties, is roughly estimated by your petitioner's engineers as aggregating $500,000, this estimate not being based upon any evidence herein, since there have not yet been any proceedings in the accountings prayed for in the said three suits, but being submitted as a carefully considered statement of counsel. The profits due to the infringing operations of the said three mining companies are believed to be a very much larger amount.

Your petitioner is advised and believes and therefore asserts that the decree herein of the Circuit Court of Appeals of the First Circuit is erroneous and the matters and questions involved in said decision are of such gravity and importance that this Honorable Court should require the said cause to be certified to it for its review and determination, in conformity with the provisions of the Acts of Congress in such cases made and provided.

WHEREFORE, because of the gravity and importance of the questions involved and in the interest of uniformity of decision, your petitioner respectfully prays that a Writ of Certiorari may be issued out of and under the seal of this Honorable Court, directed to the Judges of the United States Cir-

cuit Court of Appeals for the First Circuit, commanding that Court to certify and send to this Court for its review and determination on a day certain to be therein named, a full and complete transcript of the record and all proceedings of the said Circuit Court of Appeals in the case lately depending therein entitled on its docket No. 2259, Magma Copper Company, Defendant, Appellant, vs. Minerals Separation North American Corporation, Plaintiff, Appellee, and that the said decree of the Circuit Court of Appeals for the First Circuit may be reversed by this Honorable Court, and that your petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just.

And your petitioner will every pray.

New York, N. Y., April 22, 1929.

MINERALS SEPARATION NORTH AMERICAN CORPORATION,
By HENRY D. WILLIAMS,
WM. HOUSTON KENYON,
LINDLEY M. GARRISON,
SIDNEY ST. F. THAXTER,
FREDERIC D. MCKENNEY,
Counsel for Petitioner.

SUPREME COURT OF THE UNITED STATES.

MINERALS SEPARATION NORTH AMERICAN CORPORATION,
Petitioner,
—vs.—
MAGMA COPPER COMPANY,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

The first ground of the accompanying petition, conflict of decision between different Circuit Courts of Appeal on the same matter, sufficiently appears from the facts stated in the petition. The second ground, failure to give proper effect to applicable decisions of this Court, will now be considered, with explanation and quotation.

In the two applicable decisions of this Court, *Minerals Separation Limited* v. *Hyde*, 242 U. S. 261, and *Minerals Separation Limited* v. *Butte & Superior Mining Company*, 250 U. S. 336, the patent in suit was No. 835,120 to Sulman, Picard & Ballot, of November 6, 1906. In the instant case the patent in suit is No. 962,678 to Sulman, Greenway & Higgins, of June 28, 1910.

The two processes of the two patents (No. 835,120 of 1906 and No. 962,678 of 1910) are alike in aim (i. e. the concentration of ore) and in practical manipulation (i. e. the agitation and aeration of a so-called pulp consisting of water and the finely ground ore) and in the outward and tangible result (i. e. a mineral-bearing froth resting upon the surface of the pulp), but they are unlike in regard to the kind of frothing agent employed and in regard to its mode of operation in producing the mineral-bearing froth.

The process of patent No. 835,120 employed as the agent a fraction of one per cent of oil or other material having a

preferential affinity for the metalliferous particles submerged in the pulp, which agent in consequence of the agitation thinly coated the metalliferous particles and did not at all coat the gangue particles. It was on this preferential coating that the separation depended, for only the coated particles were picked up by the air bubbles (introduced by the agitation or otherwise) and lifted up out of the pulp in the form of a froth which could be separated.

The process of patent No. 962,678 employed as the agent a different class of materials, to wit, materials that went into solution in the water of the pulp and so modified the water that the air bubbles in the pulp preferentially picked up the uncoated metal particles (and not the gangue) and lifted them up out of the pulp in the form of a froth which could be separated. The process of patent No. 962,678 proceeded without any coating of the metalliferous particles, which coating was of the essence of the process of patent No. 835,120.

A typical claim of patent No. 835,120 of those sustained by this Court is the following (R. Vol. III, p. 181):

> "12. The process of concentrating powdered ore which consists in separating the minerals from gangue *by coating the minerals with oil in water* containing a fraction of one per cent of oil on the ore, agitating the mixture to cause the oil-coated mineral to form a froth, and separating the froth from the remainder of the mixture." *

Claim 1 of patent No. 962,678 in suit is as follows (R. Vol. II, p. 3):

> "1. The herein described process of concentrating ores which consists in mixing the powdered ore with *water containing in solution* a small quantity of a mineral frothing agent, agitating the mixture to form a froth and separating the froth."

We turn now to the two decisions of this Court with respect to patent No. 835,120.

---

* Unless otherwise indicated, bracketted portions and italicizing in quotations will be ours.

In the case of *Minerals Separation Limited* v. *Hyde,* 242 U. S. 261, this Court compared the process of patent No. 835,120 with prior art processes and distinguished it from them and held it patentably novel, referring in the course of its opinion (p. 269) to a prior decision of the House of Lords dealing with the same process in *Minerals Separation, Ltd. et al* v. *British Ore Concentration Syndicate, Limited,* 27 R. P. C. 33, stating agreement therewith and quoting from some of the opinions of the Law Lords as to the nature of the process. In the opinions in the House of Lords so quoted and throughout the opinion of this Court in the *Hyde* case reference is made to the preferential affinity of the agent used for the metalliferous matter over the gangue and to the coating of the metalliferous particles by the agent while the gangue particles remained uncoated (242 U. S. 261 at 263, 267, 269). This Court pointed out that while the preferential coating was old in earlier oil concentration processes the thinness of the oil coating was new and the lifting by the buoyancy of air was new and the resultant mineral-bearing froth was new.

In the *Butte & Superior* case this Court again reviewed the question of validity of patent No. 835,120 and said (250 U. S., at 339):

> "we see no reason for modifying our former conclusion."

Going to the new infringement questions before it and considering the *quantity* limitations of the claims of No. 835,120, this Court held as to the broader claims there involved that (pp. 341, 342):

> "the patent extends to and covers the use in the process of oils of the patent, in amounts equal to any fraction of one per cent. on the ore"

and reversed the holding of the Circuit Court of Appeals of the Ninth Circuit in that case to the effect that the use of a fraction of oil that was over one-half of one per cent. was not an infringement.

Considering the *quality* limitations of the claims—what the "oily liquid," the "oily substance," the "oil" of the claims was, to which the quantity limitation should be applied,—this Court held, affirming the Circuit Court of Appeals for the Ninth Circuit in that regard, that it included the petroleum products (fuel oil and kerosene) that had been employed by the defendant in a quantity making the whole greater than one per cent. on the ore, and of which this Court said (at p. 343):

> "It is admitted that petroleum products are 'oils having a preferential affinity for metalliferous matter.'"

Coming "to consider the nature and extent of the disclosures of the patent in suit [No. 835,120], but only with respect to the kinds and quantities of oil which may be used in the process" (at p. 346), this Court analyzed the specification and quoted from it as the "essence of the discovery" (*ib.*):

> "'We have found that if the proportion of oily substance be considerably reduced, say to a fraction of one per cent. on the ore, granulation ceases to take place, and after vigorous agitation there is a tendency for a part of the *oil-coated metalliferous matter* to rise to the surface of the pulp in the form of a froth or scum'"

and referred to an additional statement of the specification found in the description of the example of the application of the invention which statement this Court paraphrased as follows (at p. 347):

> "that the 'froth or scum' derives its power of flotation mainly from the inclusion of air-bubbles introduced into the mass by agitation, *such bubbles or air-films adhering only to the mineral particles which are coated with oleic acid.*"

Then after considering the claims this Court said (at p. 348):

> "From this consideration of the terms of the patent as written, it is apparent that it makes no differentiation whatever, either in the claims or in the specification, among the oils having a preferential affinity for

> metalliferous matter, and that its disclosure, to which the petitioners must be limited, is, that when a fraction of one per cent. on the ore of any such oil is used in the manner prescribed, there will be produced a metal-bearing froth, the result of the process."

It seems clear that this repeated and reaffirmed the decision in the *Hyde* case as to the nature of the process of patent No. 835,120 and particularly that it involved *coating the minerals* under the water of the pulp with the oil of the patent:

> "*coating* the minerals with oil in water containing a fraction of one per cent. of oil on the ore, agitating the mixture to cause the *oil-coated* mineral to form a froth" (claim 12 of No. 835,120, R., Vol. III, p. 181).
>
> "agitating the mixture until the *oil-coated* mineral matter forms into a froth" (claims 1, 2 and 3, R., Vol. III, p. 180).
>
> "agitating the mixture until the oleic acid has been brought into *efficient contact* with the mineral and has formed a froth therewith" (claims 5, 6 and 7, *ib.*).

Nevertheless the Circuit Court of Appeals in the instant case said of the decision of this Court in the *Butte & Superior* case (R. Vol. I, p. 952; 30 F. (2d) at 71):

> "This holding is a complete refutation of the statement in the patent in suit (No. 962,678) where it says that the frothing agents of the prior art are only such as are immiscible in water, to wit,
>
> > 'In the frothing processes hitherto known the substances used to secure the formation of a mineral-bearing froth has been oil or an oily liquid immiscible with water.' "

The error in this interpretation of the holding of this Court is emphasized by the contrasting opinion of the District Court in the instant case which has been reversed, wherein it is said (R. Vol. I, p. 924):

> "I consider that the decisions of the Supreme Court in the *Hyde* case and in the *Butte* case, above mentioned, are in harmony with the position of the plaintiff rather than with that of the defendant. The Court evidently regarded the first patent [No. 835,120] as a process patent limited to the use of oil or oily substances. In the *Butte* case, involving the first patent, the Court confirmed to the patentees their process claims involving the use of any of the class of oily (insoluble) mineral-frothing agents that acted by preferential affinity in coating the mineral. By implication it confirms to the patentees here their process claims involving the use of any of the class of soluble mineral-frothing agents that act on the different principle of going into solution, not coating the mineral, but modifying the water in some unknown way, to accomplish the same result in the end, i. e., bringing up to the surface the mineral particles attached to the froth."

The discovery and invention of patent No. 962,678 in suit was, as stated heretofore and in claims 1 and 2 in issue, a process of concentrating ores by agitating the powdered ore "with water containing *in solution* a small quantity of mineral-frothing agent * * * to form a froth"

or as the specification says (R., Vol. II, p. 3, ll. 61-64):

> "According to this invention the mineral-frothing agent consists of an organic compound contained *in solution* in the acidified water."

This process was founded upon a true discovery—the discovery of a new and different class of mineral-frothing agents.

An agent capable of existing "in solution" in the water of the pulp and thereby on agitation achieving mineral-froth formation and ore concentration, is and must be a different physical thing from an agent capable of existing as a coating on the metalliferous matter under the water of the pulp and thereby on agitation achieving mineral-froth formation and ore concentration.

The agents are and must be different to develop and operate by the contrary and inconsistent qualities stated, and the operations that proceed in the pulp are and must be different.

The disclosure of a process of concentrating ore

> "*by coating* the minerals with oil and water containing a fraction of one per cent. of oil on the ore, agitating the mixture to cause the *oil-coated* mineral to form a froth, and separating the froth from the remainder of the mixture" (claim 12 of No. 835,120, R., Vol. III, p. 181)

is manifestly not a disclosure of a process of concentrating ore by

> "mixing the powdered ore with water containing *in solution* a small quantity of a mineral-frothing agent, agitating the mixture to form a froth and separating the froth" (claim 1 of No. 962,678, R., Vol. II, p. 3).

The relation between coating and preferential affinity and the lifting force of air is that the preferential affinity causes the oil to preferentially coat the mineral particles under the water of the pulp (and not the gangue particles) and such coating causes the air bubbles to preferentially pick out and lift the mineral particles (and not the uncoated gangue particles) into a froth floating upon the surface of the pulp. Inevitably the agent that coats under water must to that end be insoluble, that is, immiscible, in the water. An agent that dissolved in the water could not exist as a coating on anything in that water.

The fact that complex manufactured products exist (like pine oil, for example) which are constituted in part of mineral-frothing agents that are immiscible in the water of the pulp and so are adapted to preferentially coat the metalliferous matter, and in part of mineral-frothing agents that dissolve in the water of the pulp and so are unable to coat anything in the pulp, does not alter or complicate the situation. Either constituent of such a substance if separated and used alone would achieve a froth-flotation process, the one by the principle of operation of patent No. 835,120 (if used in sufficiently small quantity) and the other by the principle of operation of patent No. 962,678; and if the complex sub-

stance were used without separation of its constituent elements both processes would simultaneously proceed and it would be a conjoint use of the two. The holding by this Court in the *Butte & Superior* case that the use of pine oil constituted an infringement of the broad claims of patent No. 835,120 did not constitute or imply a holding that that use might not also at the same time constitute an infringement of the later patent No. 962,678 for the other process, nor did it constitute or imply a holding that the two processes were really one, or that the patent for the first process anticipated the patent for the second. That question of anticipation of patent No. 962,678 by patent No. 835,120 did not arise, and was not before this Court, in the *Butte & Superior* case. This Court in that case did not, we believe and submit, either directly or indirectly pass upon that question or criticize or disapprove the decision of the Circuit Court of Appeals for the Third Circuit in respect to it. That decision of the Circuit Court of Appeals in the *Miami* case was before this Court for it is cited in the margin in the *Butte & Superior* opinion, as the last decision in the list referred to in the text, as follows (250 U. S., at 338):

> "The patent [835,120] has been so frequently described in Court proceedings,[1] that it will suffice to say of it here * * *."

These are not words of disapproval but rather of approval.

Nothing in the opinion of this Court in the *Butte & Superior* case gives support, we believe and submit, to the suggestion that this Court in that case intended to reverse or criticize or disapprove the description given of the process of patent No. 835,120, by the Circuit Court of Appeals for the Third Circuit in the *Miami* case, or the holding there made as to its bearing on patent No. 962,678.

Nothing in the decision of this Court in the *Butte & Superior* case required the Circuit Court of Appeals for the First Circuit in the instant case, as we believe and submit, to find claims 1 and 2 of patent No. 962,678 anticipated by patent No. 835,120.

Nothing in the decision of this Court in the *Butte & Superior* case, as we believe and submit, refuted the statement of the patent in suit No. 962,678 (R., Vol. II, p. 3, l. 58) as to the process of the prior patent No. 835,120:

> "In the frothing processes hitherto known the substances used to secure the formation of a mineral-bearing froth has been oil or an oily liquid immiscible with water"

because manifestly in order to *coat* the minerals with oil under water ("to cause the *oil-coated* mineral to form a froth" in accordance with the disclosure and the claims of patent No. 835,120) the oil or oily liquid must be "immiscible" with water.

It is submitted, therefore, that there is here not only (1) **a conflict of decision between two Circuit Courts of Appeals on the same matter,** but that (2) the Circuit Court of Appeals for the First Circuit in the instant case **has not given proper effect to applicable decisions of this Court,** to wit, the decisions above referred to in the *Butte & Superior* case and in the *Hyde* case.

New York, N. Y., April 22, 1929.

Respectfully submitted,

HENRY D. WILLIAMS,
WM. HOUSTON KENYON,
LINDLEY M. GARRISON,
SIDNEY ST. F. THAXTER,
FREDERIC D. McKENNEY,
Counsel for Petitioner.

FILE COPY

FILED
MAY 1
CHARLES ELMO

Supreme Court of the United States

October Term, 1928.

No. [redacted] 71

MINERALS SEPARATION NORTH AMERICAN CORPORATION,
Petitioner,

—vs.—

MAGMA COPPER COMPANY,
Respondent.

REPLY BRIEF FOR PETITIONER ON PETITION FOR WRIT OF CERTIORARI.

The brief for respondent sets forth as findings of fact, as though made by the trial Court, the opinions on matters of theory adopted by a majority of the Appellate Court. The so-called "facts" of Point 1 of Brief for Respondent are not facts in the legal sense but are "theories" developed to meet the exigencies of the case. They deal with magnitudes as negligible for all practical purposes as the statement that glass is soluble in water (R., Vol. 1, p. 357, XQ. 72). The District Court dealt wisely with these theories (R., Vol. 1, p. 923, last paragraph, and following page). It is submitted that the essential facts as to the subject matter decided by the First Circuit Court of Appeals in the instant case are substantially the same as in the case decided by the Third Circuit Court of Appeals. The same processes were under consideration and substantially the same documents describing these processes.

On page 11 of Brief for Respondent, as printed, there is a misquotation from the decision of this Court in the *Butte & Superior* case. This misquotation, appearing on lines 13 and 14, is as follows:

> "non-frothing oils (immiscible, if such there are) having the required affinity."

The words within the parentheses are not in the decision of this Court, and further, even as an interpolation, are unjusti-

fied. The attention of respondent's counsel was immediately called to the misquotation and it was said by them that the parentheses would be changed to brackets, and this has probably been done by way of correction. Nevertheless the interpolation is wholly unjustified. The error probably arose through an erroneous quotation from the decision of this Court in the opinion of the Circuit Court of Appeals for the First Circuit. This Court said in the opinion in the *Butte & Superior* case (250 U. S. at 249, 250) discussing the contention of the plaintiffs-petitioners in that case that the highly immiscible and insoluble petroleum oils were not frothing oils and not within the claims:

> "It is argued that the provision of the claims that the mixture prescribed, of oil, water, and ore, shall be agitated until the oil-coated mineral matter forms into a froth, serves to differentiate the 'frothing oils' from others having the required preferential affinity for metalliferous matter, but which, when agitated in the mixtures, may not produce the characteristic froth, if any such there are, and that a proper construction of the patent limits it to such 'frothing oils,' and renders the use of them in a fraction of 1 per cent on the ore an infringement when used with 'non-frothing oils' having the required affinity in amounts sufficient to make the combination exceed the quantity limit of the patent."

In the opinion of the Circuit Court of Appeals for the First Circuit (Vol. I, p. 951, last paragraph, continued on p. 952) this paragraph was broken up into two quotations and from the second of these quotations essential words were omitted and to it unjustified interpolations were added. At page 951, line 7 from the bottom, the words "for metalliferous matter" after "affinity" were omitted. In line 5 from the bottom the words "if any such there are," following the word "froth," were omitted from the quoted part and inserted in the interpolation, but were preceded there by the word "immiscible." The same unjustified interpolation was repeated on the bottom line of page 951 and top line of page 952.

What this Court said referred to oils having the required preferential affinity for metalliferous matter which might not produce the characteristic froth. By the erroneous quotation and interpolations this was changed to indicate a doubt expressed by this Court as to the immiscibility of these highly immiscible and insoluble petroleum oils. No such doubt was expressed by this Court.

Respondent's Brief (p. 11, ll. 13, 14) gives the quotation first above stated as from the decision of this Court repeating the same unjustified interpolation, and thus erroneously presents the conclusions of this Court expressed in the *Butte & Superior* case.

It is deemed advisable to submit the foregoing in order that the Court may not be left with the impression that petitioner admits the statements or deductions set forth in Respondent's Brief. Petitioner submits, however, that such matters are for consideration of the Court on the merits when the Petition for Certiorari shall have been granted and the case docketed in this Court.

New York, N. Y., May 10, 1929.

Respectfully submitted,

HENRY D. WILLIAMS,
WM. HOUSTON KENYON,
LINDLEY M. GARRISON,
SIDNEY ST. F. THAXTER,
FREDERIC D. McKENNEY,
Counsel for Petitioner.

(4204)

Alpert Press, 40 Flatbush Avenue Extension, Brooklyn, N. Y. Tel. TRIangle 1058-1059